

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-22 are currently being prosecuted. The Examiner is respectfully requested to reconsider her rejections in view of the amendments and remarks as set forth below.

Rejection under 35 U.S.C. § 103

Claims 1-4, 6, 7, 11, and 12 stand rejected under 35 U.S.C. § 103 as being obvious over Edwards et al. (U.S. Patent No. 5,536,240) in view of Singh (U.S. Patent No. 6,599,237). This rejection is respectfully traversed.

The Examiner points out that Edwards et al. teaches a catheter probe 182, with an elongated body 184 having a longitudinal bore, and at least one outlet opening 216 from a catheter tube 54 with a proximal sharp end 56. The Examiner admits Edwards et al. does not teach the use of a urethral probe made of a material to be perforated.

The Examiner relies on Singh to teach a urethral probe 10 for accommodating other surgical instruments which acts like an artificial protective lining. The Examiner points out that the probe can be made of rubber which allows it to be perforated. The Examiner points out that the probe can be split if an oversized instrument is placed within it. The Examiner feels it would have been obvious to use the urethral probe taught by Singh with a catheter probe with Edwards et al.

Applicants submit that claim 1 as amended is obvious over this combination of references. Claim 1 has been amended to make it clear that the urethral probe can be perforated at arbitrary positions relative to the prostate. This limitation is found in the original Specification in the last paragraph on page 6 which is paragraph 0029 in the published application. This limitation makes it clear that the proximal sharp end of the catheter tube can pierce the urethral probe at any position. Thus, it is not necessary that it occur at specific positions. This allows a more flexible use of the urethral probe device.

In the Singh reference, the sheath has a rupture line 71 which allows the sheath to expand in diameter when a large medical tool is inserted. This differs from the present invention where the urethral probe has an inner dimension at least slightly larger than the outer dimension of the catheter probe. Further, on the Singh device, frictional contact will still exist between the medical tool and the inner wall of the urethra. This does not occur in the present invention.

Further, since the present invention is now defined as having urethral probe made up of a material to perforated by the proximal sharp end of the catheter tube at arbitrary positions, it is clear that the claim is not obvious over Edward et al. in view of Singh.

Claims 2-22 depend from claim 1 and as such are also considered to allowable. In addition, each of these claims include other features that make them additionally allowable. Thus, claim 4 specifically describes the size of the probe bore in relation to the catheter probe. Other claims similarly include other limitations such as the material used for the probe.

Claim 5 stand rejected under 35 U.S.C. § 103 as being obvious over Edwards et al. and Singh further in view of Shiber (U.S. Patent No. 5,135,531). Claims 8-10, 18 and 19 stand rejected under 35 U.S.C. § 103 as being obvious over Edward et al and Singh and further in view of Kindlein et al. (U.S. Patent No. 6,454,696). Claim 13 stand rejected under 35 U.S.C. § 103 as being obvious over Edwards et al. and Jagpal (U.S. Patent No. 5,257,979) and further in view of Webster (U.S. Patent No. 5,569,220). Claims 14-17 stand rejected under 35 U.S.C. § 103 as being obvious over Edwards et al., Jagpal and Webster and further in view of Tiller et al. (U.S. Published Application 2003/0091641). Claims 20 and 21 stand rejected under 35 U.S.C. § 103 as being obvious over Edwards et al and Singh and further in view of Bradshaw et al. (U.S. Patent No. 5,139,473). Claim 22 stand rejected under 35 U.S.C. § 103 as being obvious over Edwards et al. over Singh and further in view of Hung et al. (U.S. Patent No. 6,391,026). These rejections are respectfully traversed.

Applicants submit that even if the secondary references show the various features of the dependent claims, these claims remain allowable based on their dependency from allowable claim 1.

Conclusion

In view of the above remarks, it is believed that claims clearly distinguish over the patents relied on by the Examiner, either allow or in combination. In view of this, reconsideration of the rejection and allowance of all the claims are respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert F. Gnuse, Reg. No. 27,295, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

Joe McKinney Muncy
Registration No.: 32,334
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

ROBERT F. GNUSE
Registration # 27295